

## **REMARKS**

With this Response, Applicants elect Claim Group I (claims 1-22) with traverse. Claims 23-76 are withdrawn. Therefore, claims 1-22 are pending.

## **ELECTION/RESTRICTION**

The Office Action asserts that the claims are directed to different inventions, according to the following claim groups:

Group I: Claims 1-22

Group II: Claims 23-40

Group III: Claims 41-51

Group IV: Claims 52-76

Applicants hereby elect Claim Group I with traverse.

## **TRAVERSE OF ELECTION/RESTRICTION**

The Office Action asserts at pages 2-3 that Group I is related to Groups II, III, and IV as combination and subcombination. The Office Action refers to the test for distinctness in that claims in this relationship are distinct if it is shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations. The Office Action then asserts "In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because of the reasons above." Applicants note that there are no reasons above. The only thing above this statement is the Office Action's cursory remarks as to what classes it is assigning to the various Claim Groups. The class assignment fails to provide reasons as to what "particulars" of the claims of the subcombinations are not required for patentability by the combination. Thus, the Office Action has failed to provide reasoning to

show that the combination as claimed does not require the subcombination as claimed for patentability.

Applicants further note that MPEP §803 establishes that a *prima facie* case of proper requirement for restriction requires **both**:

- (A) The inventions must be independent or distinct; and
- (B) There must be a serious burden on the examiner.

Even assuming the distinctness or independence of the separate Groups, which Applicants have addressed above, Applicants submit that examination of the entire application would not be a serious burden on the Examiner. Applicants recognize that there are a great number of claims in the above-referenced application, which may require significant effort in examining.

Nevertheless, Applicants note that many or all of the features of the independent claims of the Groups the Office Action has referred to as being subcombinations are in fact included in the claims depending from claim 1. Assuming that the Examiner will perform a diligent search and determine whether the elements of the independent and its dependent claims are disclosed in the prior art, Applicants cannot understand that there would be a serious burden on the Examiner to apply the results of the search for Group I to the other Groups. Searching for the elements of Group I should necessarily be applicable to similar or common elements of the other Groups. Therefore, Applicants submit that in accordance with MPEP §803, "the search and examination of [the] entire application can be made without serious burden, [thus,] the examiner **must examine it on the merits**, even though it includes claims to independent or distinct inventions." MPEP §803.

Furthermore, Applicants observe that separation of Groups related as subcombinations disclosed as usable in a single combination, such as may be true of Groups II and III, for

example, is improper. Restriction of related subcombinations is proper only if the practice under both election of species (MPEP §808.01(a)) and election of related inventions (MPEP §808.02) is satisfied. Practice under election of species states "election of species **should not be required** if the species claimed are considered clearly **unpatentable (obvious) over each other.**" Emphasis in original. Applicant respectfully requests reasoning be given as to how the claims of the subcombinations would not render obvious the other subcombinations. To the extent that such reasoning cannot be provided, Applicants submit that restriction of the subcombinations is improper.

Therefore, Applicants submit that a *prima facie* case of proper restriction requirement has not been established, and respectfully requests that the restriction be withdrawn.

#### CONCLUSION

Applicants have made an election with traverse. For at least the foregoing reasons, Applicants submit that the restriction requirement is improper, and contends that examination should proceed on the application as a whole. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the above-referenced application.

Please charge any shortages and credit any overcharges to our Deposit Account number  
02-2666.

Respectfully submitted,  
**BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP**

Date: 11/19/04

Vincent H. Johnson

Vincent H. Anderson  
Reg. No. 54,962

12400 Wilshire Blvd.  
Seventh Floor  
Los Angeles, CA 90025-1026  
Telephone: (503) 439-8778

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